

### **REMARKS**

In the Office Action, claims 1-8 were pending, and claims 1-8 were rejected.

Please consider the following remarks.

#### **I. Rejections under 35 U.S.C. §112**

In the Office Action at page 2, number 3, claims 1-8 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleges the claims contain subject matter-exclusion of R groups containing a primary amine- which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

The rule of law is as follows: the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In this instance, the specification as a whole, including the examples provided therein, reasonably conveys to a person having ordinary skill in the art that inventors had possession of the subject matter- an aliphatic amine of the formula R-NH<sub>2</sub> wherein R is a C<sub>4</sub>-C<sub>30</sub> hydrocarbyl group which does not contain a primary amine (i.e., a negative limitation)- at the time the application was filed. The specification as a whole, including the examples provided therein, reasonably conveys to a person having ordinary skill in the art that the claimed composition does not require an aliphatic amine of the formula R-NH<sub>2</sub> wherein R is a C<sub>4</sub>-C<sub>30</sub> hydrocarbyl group which does not contain a

primary amine. Therefore, Applicants respectfully request the withdrawal of this rejection.

## **II. Rejection under 35 U.S.C. §102**

In the Office Action at page 3, number 4, claims 1-4 and 6 were rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 4,505,835 ("Sung"). Applicants respectfully traverse this rejection.

### **A. The Present Invention**

The present invention as recited in claim 1 is a power transmission fluid composition which comprises: (a) a major amount of an oil of lubricating viscosity; (b) an effective amount of a power transmission fluid performance additive package; and (c) a static friction reducing amount of a member selected from the group consisting of the reaction products of maleic or succinic acid or anhydride or a C<sub>1</sub>-C<sub>6</sub> alkyl substituted maleic or succinic acid or anhydride with a primary aliphatic amine of the formula R-NH<sub>2</sub> wherein R is a C<sub>4</sub>-C<sub>30</sub> hydrocarbyl group which does not contain a primary amine.

### **B. Sung**

Sung discloses a cylinder lubricant composition comprising a mineral lubricant and a friction modifying amount of a reaction product between an amine and specific maleic anhydride.

### **C. Traversal of the Rejection**

Under 35 U.S.C. §102, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The present invention as recited in claim 1 is a composition comprising a static friction reducing amount of a member selected from the group consisting of the reaction products of maleic or succinic acid or anhydride or a C<sub>1</sub>-C<sub>6</sub> alkyl substituted maleic or succinic acid or anhydride with a primary aliphatic amine of the formula R-NH<sub>2</sub> wherein R is a C<sub>4</sub>-C<sub>30</sub> hydrocarbyl group which does not contain a primary amine. Due to the nature of the recited reaction, the claimed reaction product is a succinimide having a closed ring.

Sung discloses the reaction product of an amine and a specified maleic anhydride. The maleic anhydride contains an R group having a branched structure. Further, Sung discloses the stoichiometry for the reaction is 2 moles of amine and 1 mole of maleic anhydride. Given the disclosed reactants and the stoichiometry of the reaction, the reaction product disclosed in Sung is NOT a closed ring succinimide like the reaction product of the present invention as recited in claim 1.

Therefore, Sung does not disclose each and every element of the invention as recited in claim 1. Specifically, Sung does not disclose the reaction product of claim 1 because the reactants and stoichiometry of the reaction in Sung are different from those recited in claim 1. As a result, Applicants respectfully request the withdrawal of this rejection.

Claims 2-4 and 6 depend on claim 1 and recite the invention in further embodiments. For the reasons discussed above, Sung does not disclose a composition comprising the reaction product recited in claim 1 as further recited in claims 2-4 and 6. Therefore, Sung does not disclose each and every element of the invention as recited in

claims 2-4 and 6 as required for a proper rejection under section 102. Applicants respectfully request the withdrawal of this rejection.

### **III. Rejection under 35 U.S.C. §103**

In the Office Action at page 4, number 5, claims 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sung in view of US Patent No. 5,344,579 ("Ohtani"). Specifically, the Examiner alleges that it would have been obvious to one of ordinary skill in the art to include the fluid disclosed by Sung in an automatic transmission or other power transmission device as taught in Ohtani (see col. 1, line 21 of Ohtani). Applicants respectfully traverse this rejection.

#### **A. Ohtani**

Ohtani discloses a lubricant additive composition which comprises at least the following components: a) a hydroxyalkyl aliphatic imidazoline in which the hydroxyalkyl group contains from 2 to about 4 carbon atoms, and in which the aliphatic group is an acyclic hydrocarbyl group containing from about 10 to about 25 carbon atoms; and b) a di(hydroxyalkyl) aliphatic tertiary amine in which the hydroxyalkyl groups, being the same or different, each contain from 2 to about 4 carbon atoms, and in which the aliphatic group is an acyclic hydrocarbyl group containing from about 10 to about 25 carbon atoms; said components a) and b) being present in a mol ratio in the range of about 0.005 to about 0.50 mol of a) per mol of b).

#### **B. Traversal of the Rejection**

For a proper rejection under Section §103, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present invention as recited in claim 7 is an inventive composition comprising an inventive reaction product as recited in claim 1 in a power transmission device. The present invention as recited in claim 8 is an inventive composition comprising an inventive reaction product as recited in claim 1 in an automatic transmission apparatus.

As stated above, Sung does not disclose the inventive composition comprising the inventive reaction product recited in claim 1 because the reactants and the stoichiometry of the reaction in Sung are different from those recited in claim 1. Further, Sung does not teach or suggest the inventive composition comprising the inventive reaction product recited in claim 1. Similarly, Sung does not teach or suggest the inventive composition comprising the inventive reaction product recited in claims 7 and 8.

The Examiner is using the Ohtani reference to negate the patentability of including the inventive composition as recited in claim 1 in a power transmission device (as recited in claim 7) and in an automatic transmission apparatus (as recited in claim 8). Because Sung does not teach or suggest the claimed composition, the combination of Sung and Ohtani does not teach or suggest the claimed inventive composition comprising the inventive reaction product in a power transmission device as recited in claim 7 and in

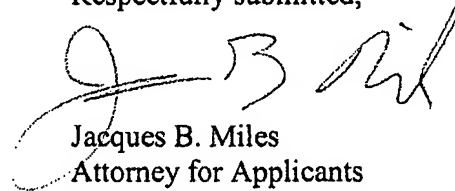
Appl. No. 10/731,800  
Response Dated October 12, 2007  
Reply to Office Action of July 12, 2007

an automatic transmission apparatus as recited in claim 8. Therefore, Applicants respectfully request the withdrawal of this rejection of claims 7 and 8.

#### **VII. Conclusion**

Based upon the foregoing, it is submitted that the claimed invention now claimed is in condition for allowance. The Applicants therefore request that the application now be passed to issue.

Respectfully submitted,



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